

REMARKS/ARGUMENTS

These remarks are responsive to the Office Action dated May 7, 2004. This response was necessitated by the Examiner's continued rejection of the claims based upon a misapplication of the cited art to the present claims. Claims 1-77 are pending in this application. Only claims 1, 34, 56, and 73 are independent. Claims 3, 4, 29, 30, 35, 47, 55, 58, 59, 68 and 77 are said to be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. Claim 29 is objected to for including a misplaced "5" but is said to be allowable if this is corrected. Applicant has amended claim 29 to delete the "5".

In the Office Action, dated May 7, 2004 the Examiner rejected claims 1, 2, 5-12, 16, 21-23, 31-34, 36-46, 50-54, 56, 57, 60-64, 66, 67, 71 and 73 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,252,588 to Dawson ("Dawson"). These rejections are respectfully traversed.

The Examiner also rejected claim 73 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,937,050 to Yue *et al.* ("Yue"). This rejection is respectfully traversed.

The Examiner also rejected claims 73 and 75 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,233,318 to Picard *et al.* ("Picard"). These rejections are respectfully traversed.

In the Office Action, dated May 7, 2004, the Examiner rejected claims 1, 9-15, 17-20, 34, 48, 56, 62-65, 69, 73 and 74 under 35 U.S.C. 103(a) as being unpatentable in view of U.S. Patent No. 5,568,540 to Greco *et al.* ("Greco") in view of Dawson. These rejections are respectfully traversed.

In the Office Action, dated May 7, 2004, the Examiner rejected claims 24, 25 and 68 under 35 U.S.C. 103(a) as being unpatentable over Dawson in view of Picard and further in view of U.S. Patent No. 5,875,588 to Koralewski et al. ("Koralewski"). These rejections are respectfully traversed.

In the Office Action, dated May 7, 2004, the Examiner rejected claims 26-28, 49, 69 and 76 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson and further in view of U.S. Patent No. 5,778,054 to Kimura *et al.* ("Kimura").

The Examiner rejected claims 27 and 76 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson and Kimura and further in view of Picard. This rejection is respectfully traversed.

The Examiner rejected claims 33 and 72 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson and further in view of Kimura and further in view of U.S. Patent No. 5,651,054 to Dunn et al. ("Dunn"). These rejections are respectfully traversed.

Allowable Subject matter

Applicants would like to thank the Examiner for the indication that claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68 and 77 would be allowable if rewritten to include all of the limitations of the base claim and any intervening claims. However, for the reasons stated below, applicants respectfully assert that the base claims and any intervening claims are novel over the cited art and as such claims 3, 4, 24, 25, 29, 30, 35, 47, 55, 58, 59, 68 and 77 do not need to be rewritten.

Claim 1 of the Present Application

Claim 1 of the present application includes a method of indicating a receipt of a stored message from a source. The method includes generating an information signal relating the stored message to at least one graphical image associated with the source, transmitting the information signal to a communications device associated with an addressee of the stored message, and indicating the receipt of the stored message in response to a receipt of the information signal by the communications device.

Dawson

Dawson discloses an email system wherein a sender of an email selects a recipient's address by selecting an image associated with the recipient. Before the email message is sent (i.e. before the message is stored), an image associated with the sender of the email is attached to the email message. (col. 30 ll. 34-54).

35 U.S.C. 102(e)

The Examiner rejected claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73 under 35 U.S.C. 102(e) as being anticipated by Dawson. According to the Examiner,

Dawson discloses a method and apparatus for providing an audio-visual email system. Dawson teaches that in incoming email notifications, standard e-mail addresses of senders are replaced by thumbnail pictures of the senders (col. 9, ll. 41-52, col. 30 ll. 42-46). Dawson teaches generating an information signal by extracting a sender's thumbnail picture (by an e-mail server) from an e-mail message's header, relating a stored e-mail message to a senders (source) graphical image (thumbnail picture of the sender) and transmitting the information signal (thumbnail picture) to a recipient's e-mail apparatus (communication device) for indicating receipt of the stored e-mail message (Figure 10; col. 9, ll. 49-52; col. 16, ll. 56-67; col. 30 ll. 42-46).

In response to applicant's previous reasoning why the Examiner's interpretation and application of Dawson is incorrect, the Examiner states "extracting the thumbnail picture is generating the information signal, because the thumbnail picture itself is the informational signal." (pg. 17 of May 7, 2004 Office Action). Applicants once again respectfully disagree with the examiner's interpretation and application of Dawson and with Examiner's interpretation of applicants' claim.

Claim 1 of the present application includes, *inter alia*: generating an information signal relating the stored message to at least one graphical image associated with the source and transmitting the information signal to a communications device associated with an addressee of the stored message. Respectfully the Examiner misconstrues and misapplies Dawson and takes inconsistent positions, which can only be supported using the present application as a roadmap. However, as the Federal Circuit has held,

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. . . One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention.

W.L. Gore Associates Inc. v. Garlock, Inc., 721 F.2d 1540, 1553 (Fed. Cir. 1983),

The informational signal being generated in the present application is generated upon receipt and storage or subsequent to receipt and storage of a message (i.e. the message for which the information signal is being generated is a stored message). In contrast, Dawson attaches the images to the email message before sending the message (Fig. 4, elements 411 and 413; col. 30

ll. 43-54). Thus, the image is not “relating [a] stored message” to anything because at the point that the Dawson system attaches the image to the email message there is no stored message. If however, the Examiner takes the position, as he did, that the generation of the information signal in Dawson is accomplished by “extracting a sender’s thumbnail picture. . .” then Dawson necessarily fails to disclose “transmitting the informational signal.” Again, at the time the image is transmitted in Dawson the message has not been stored. Thus, either Dawson fails to disclose “generating an information signal relating the stored message . . .” or it fails to disclose “transmitting the information signal to a communications device. . .” Either way it does not disclose every element of claim 1. This same reasoning can be applied to the rejections of each of the independent claims. The remaining claims that were rejected over Dawson are dependent upon the independent claims and thus are novel over Dawson for at least the reasons discussed above. Since Dawson fails to anticipate these claims, Applicants respectfully request that the Examiner reconsider and withdraw his rejections of claims 1, 2, 5-11, 16, 21-23, 31-34, 36-46, 50, 56, 57, 60-64, 66, 67, 71 and 73 as anticipated by Dawson.

Claim 73

In the May 7, 2004 Office Action, the Examiner rejected claim 73 under 35 U.S.C. 102(e) as being anticipated by Yue. This rejection is respectfully traversed.

According to the Examiner, “Yue teaches that a user has option (*Sic.*) when accessing a voice messaging system in figure 13A and 13B. Yue teaches that when the user chooses to listen to voice mail envelope information, the voice messaging system generating (*Sic.*) an information signal. . .for indicating receipt of a voice message.” Applicants respectfully disagree with the

Examiner's reading of Yue and point out that the Examiner is confusing the difference between identifying a message that the user is already aware of and indicating receipt of a message, which makes the user aware that a message has arrived and been stored. According to the specification of Yue, "The voice mail service of the present invention optionally provides subscribers with numeric or alphanumeric paging notification for every voice mail message received." (col. 4 ll. 55-57). Thus the "indication" is either numerical or alphanumeric it is not a graphical image or a digital representation of a sound waveform. Since Yue fails to disclose every element of Claim 73, Claim 73 is not anticipated by Yue and applicants respectfully request Examiner to reconsider and withdraw his rejection.

Claims 73 and 75

In the May 7, 2004 Office Action, the Examiner rejected claims 72 and 73 under 35 U.S.C. 102(e) as being anticipated by Picard. This rejection is respectfully traversed.

The Examiner asserts that Picard teaches every element of claim 73. Applicants respectfully point out that the Examiner's allegedly supporting citations to Picard are unrelated statements. A correct reading of Picard reveals that the notification mechanism in Picard does not disclose the elements of Claim 73. In particular, Picard discloses that the notification of messages merely indicates the number of messages that have arrived. (col. 6 ll. 48-55 "when the voice interface is used, the presentation is preferably limited to simple spoken message counts ('You have three new voice messages, one new facsimile message, and two new E-mail messages and one new video message. One voice message is urgent.'). The various citations made by the Examiner relate in one instance to the notification of the message, which is

discussed above, and the identification of the message, which is not the same as the notification. As illustrated by col. 6 ll. 35-46, the message envelope that includes the sender's information is stored with the message and travels along with the message, but is not provided to the recipient until he logs into his mailbox and selects a message for retrieval. Thus, as with Yue discussed above, Picard fails to disclose generating an information signal relating the stored message to at least one of: (i) a graphical image associated with the source; and (ii) a digital representation of a sound waveform associated with the source. Claim 75 depends from claim 73 and thus is novel over Picard for at least the reasons discussed above. Thus, since Picard fails to disclose every element of Claims 73 and 75 applicants respectfully request that the Examiner reconsider and withdraw this rejection of Claims 73 and 75.

35 U.S.C. 103(a)

In the Office Action, dated May 7, 2004, the Examiner rejected claims 1, 9-15, 17-20, 34, 48, 56, 62-65, 69, 73 and 74 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson. These rejections are respectfully traversed.

The Examiner stated that Greco teaches every element of the independent claims except including a graphical image in the information signal. The Examiner then cites to Dawson for the teaching of a digital image in the information message. Applicants respectfully point out to the Examiner, as stated above, that Dawson does not provide an information signal which relates a stored message to a graphical image. Instead Dawson provides a digital image in the header of the message that is being sent from the message originator to the message recipient. The digital image that is being transmitted (i) is not in an information signal and (ii) is not related to a stored message when it is being transmitted. As such, Dawson does not cure the deficiencies of Greco

and could not be used to cure the deficiencies of Greco without using improper hindsight. For at least the foregoing reasons, claims 1, 2, 9-11, 13-15, 26, 28, 34, 48, 49, 56, 62-65, 69, 73 and 74 are not rendered obvious by the combination of Greco and Dawson and applicants respectfully request that the Examiner reconsider and withdraw his rejections thereto.

In the Office Action, dated May 7, 2004, the Examiner rejected claims 24, 25 and 68 under 35 U.S.C. 103(a) as being unpatentable over Dawson in view of Picard and further in view of U.S. Patent No. 5,875,588 to Koralewski et al. ("Koralewski"). These rejections are respectfully traversed.

According to the Examiner, Dawson teaches every element of this claim except including digital representation of a sound waveform associated with the sender. According to the Examiner, Picard teaches that the sender's address may be announced to a recipient in a synthesized voice and Koralewski teaches generating a visual and audio notification signal to alert a called party so the called party may decide whether to answer the incoming call or not. As discussed above, Dawson and Picard both fail to disclose every element of the dependant claims. Koralewski fails to cure the deficiencies of Dawson and Picard. The notification in KoraLewski is, among other things, also not related to a stored message. Since Dawson fails to disclose the elements of 24, 25 and 68 and Picard and Koralewski do not cure the deficiencies of Dawson, Claims 24, 25 and 68 are not rendered obvious by the combination. Thus, applicants respectfully request the Examiner to reconsider and withdraw these rejections of Claims 24, 25 and 68.

The Examiner rejected Claims 26- 28, 49 and 69 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson and further in view of Kimura. These rejections are respectfully traversed.

Claims 26-28, 49 and 69 are each dependant claims. According to the Examiner, "Greco modified by Dawson teaches including a graphical image for replacing as an email address, but fails to teach deriving the graphical image from a video frame from a video stream." However, the Examiner asserts that "Kimura teaches adding an image from video information to the directory number so that a person associated with the directory number can be easily identified." For the reasons stated above, the independent claims are not rendered obvious by the combination of Greco and Dawson. The addition of Kimura fails to cure the deficiencies of Greco and Dawson, thus for at least this reason, claims 26-28, 49 and 69 are novel. Thus, applicants respectfully request that the Examiner withdraw the rejections of Claims 26-28, 49 and 69.

The Examiner also rejected Claims 33 and 72 under 35 U.S.C. 103(a) as being unpatentable over Greco in view of Dawson, further in view of Dunn. These rejections are respectfully traversed.

Claims 33 and 72 depend from Claims 1 and 56 respectively. For the reasons stated above, neither claim 1 nor claim 56 is rendered obvious by the combination of Greco and Dawson. Dunn does not cure the deficiency of this combination since Dunn also does not teach or suggest an information signal which relates a stored message to a graphical image. As such, since the base claims from which these two claims depend are both novel over the asserted

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combination, Claims 33 and 72 are novel for at least the same reasons. As such, applicants respectfully request that the Examiner withdraw the rejections of Claims 33 and 72.

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

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Respectfully submitted,



Richard M. Lehrer
Reg. No.: 38,536
MINTZ LEVIN COHN FERRIS
GLOVSKY AND POPEO PC
Chrysler Center
666 Third Avenue
New York, NY 10017
212-935-3000

NYC 298380v1